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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/341,328	07/06/1999	SATOSHI MIKAMI	KINOSHITACA	4999

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EXAMINER

PULLIAM, AMY E

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 04/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/341,328	MIKAMI ET AL.
Examiner	Art Unit	
Amy E Pulliam	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 October 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) Interview Summary (PTO-413) Paper No(s) _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Receipt is acknowledged of the Notice of Appeal, received August 27, 2001, as well as the Request for a CPA and Preliminary Amendment C, both received October 23, 2001.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,496,544 to Mellul *et al.* Mellul *et al.* disclose a cosmetic composition for skin consisting of a powder and a silicone resin mixture (abstract). Mellul *et al.* further teach that face powders and the like usually consist of coloured or non-coloured powders and a fatty binder, which is then applied to the skin by means of an applicator such as a sponge, powder puff, or brush (c 1, l 13-23). Mellul *et al.* disclose a cosmetic composition with a powder comprising a solid particulate phase mixed with a fatty binder containing a silicone mixture (c 2, l 48-58).

Mellul *et al.* teach an organic powder, which suggests applicant's claim to a natural organic powder. It is the position of the examiner that the term organic can be interpreted to mean natural, being that organic can be defined as something derived

from living organisms. Therefore, Mellul *et al.*'s teachings to any organic powder render applicant's claims obvious. Additionally, the examiner refers to column 6, line 9 of the reference, which teaches that starch can be included in the powder composition as a filler. Starch is a natural, organic material, and therefore fulfills the requirement for a natural, organic material in the powder composition. Furthermore, applicant's claims 24-29 include specific examples of what applicant is referring to as a natural, organic powder. This list includes cellulose and collagen, among others, and is therefore rendered obvious by Mellul *et al.*'s teaching of starch, as well as the teaching in column 6, line 56, where Mellul *et al.* teach that collagen can be included in the powder composition.

It is the position of the examiner that Mellul *et al.*'s invention reads on applicant's claims. Applicant is claiming an applicator with a powder adhered to the side which will touch the skin. Mellul *et al.* teach that powder puffs, applicators, and sponges are well known in the cosmetic art to apply facial powder and the like to the skin. Further, applicant claims that the powder adheres to the applicator through a treatment with a resin mixture. Mellul *et al.* teach a powder mixed with a silicone resin mixture (weight percents discussed in c 2, l 61), and teaches that it is applied to the skin in the usual methods (c 7, l 51-52). Mellul *et al.* do not teach the specific particle size of the powder. However, it is the position of the examiner that the specific particle size is a limitation that would be routinely determined by one of ordinary skill in the art, through minimal experimentation, as being suitable, absent the presentation of some unusual and/ or unexpected results. The results must be those that accrue from the specific limitations.

Therefore, it is the position of the examiner that one of ordinary skill in the art would have been motivated to use a well known applicator (as discussed by Mellul *et al.*) to apply a cosmetic composition comprising a powder and a silicone resin mixture, as taught by Mellul *et al.*. One of ordinary skill in the art would expect an improved cosmetic composition. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Response to Arguments

Applicant's arguments filed October 23, 2001 have been fully considered but they are not persuasive.

In the interview, it was suggested by the examiner that the claims be limited to define the articles, the powder, and the sizes. Applicant submits that these limitations are present in dependant claims. The examiner notes that the powder sizes are present in the dependant claims, however, this does not affect the status of the generic claims. Additionally, the examiner still asserts that the specific particle size is a limitation which is routinely manipulated in the cosmetic and pharmaceutical art. Absent a clear showing of criticality, the determination of particular particle sizes is within the skill of the ordinary worker as part of the process of normal optimization. Lastly, there is *no* teaching in the cited reference as the particle size of the organic powder. Therefore, it is entirely possible that the particle size is the same. The Office does not have the facilities for examining and comparing applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same

material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed products are functionally different than those taught by the prior art and to establish patentable differences. See *Ex parte Phillips*, 28 U.S.P.Q.2d 1302, 1303 (PTO Bd. Pat. App. & Int. 1993), *Ex parte Gray*, 10 USPQ2d 1922, 1923 (PTO Bd. Pat. App. & Int.) and *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). Furthermore, the limitations present in the dependant claims which further define the powder itself are rendered obvious by the reference.

Applicant additionally argues that Mellul *et al.* do not teach that the powder be “firmly adhered” to the side of the base layer which contacts the skin. The examiner maintains her position on this limitation. In using a powder puff to administer a cosmetic powder to the face, it is essential that the powder adhere to the powder puff prior to application, or the powder would never be lifted from the container to be applied onto the skin. Additionally, after using a cosmetic powder puff for application to the face, the puff maintains the color of the powder. This further proves that the powder is “firmly adhering” to the puff.

It is further the position of the examiner that this limitation is not patentably significant. Simply because Mellul *et al.* are silent regarding applicant’s specific terminology (firmly adhered), does not mean that the powder is not firmly adhered to the applicator. Further, it is the position of the examiner that the powder would have to be firmly adhered to the base layer in order to be functional as a makeup applicator. Additionally, the examiner considers that the phrase “firmly adhered” can be interpreted

broadly, and therefore is no different than a powder which is simply adhered to the base layer. Lastly, the Office does not have the facilities for examining and comparing applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed products are functionally different than those taught by the prior art and to establish patentable differences. See *Ex parte Phillips*, 28 U.S.P.Q.2d 1302, 1303 (PTO Bd. Pat. App. & Int. 1993), *Ex parte Gray*, 10 USPQ2d 1922, 1923 (PTO Bd. Pat. App. & Int.) and *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977).

Furthermore, applicant has added new claims which add the surfactants and thickening agents. It is first the position of the examiner that surfactants and thickeners are well known in cosmetic compositions, in order to affect the consistency of the formulation. However, in further evidence of this, at column 6, line 60 though column 7, line 14, Mellul *et al.* teach that various additives can be added to the formulation. Specifically, Mellul *et al.* discusses consistency agents, such as natural and synthetic gums, as well as emollient agents and moisturizing agents. It is the position of the examiner that although Mellul *et al.* does not disclose each of the specific additives disclosed by applicant, the reference does teach the inclusion of additives in general, and specifically mentions consistency agents. It is the position of the examiner that one of ordinary skill in the art would have been motivated to include any well known consistency agents in the composition of Mellul *et al.*, in order to produce a more

suitable cosmetic. For these reasons, this rejection is maintained, and applied to the newly added claims.

Claims 12-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,776,497 to Lagrange *et al.*. Lagrange *et al.* disclose a mineral or organic particle based product, wherein the product is a powder which consists of mineral or organic particles smaller than 200 microns (abstract). Lagrange *et al.* further teach that the product is to be used in cosmetics (c 1, l 10, and the reference specifically discusses the formulation's use as a powder to be applied with a powder puff or a brush (c 14, ex. 7). Although Lagrange *et al.* teach in general that the particles be less than 200 microns, the reference further teaches that the particles, in particular be between 1 and 20 microns (c 4, l 46). Furthermore, Lagrange *et al.* teach that substances such as chitin, cellulose, wool, and silk can all be included in the composition (c 5, l 35-44). Additionally, Lagrange *et al.* teach that the makeup compositions of the present invention can also contain thickeners, and anionic and cationic substances (c 9, l 23-24). It is the position of the examiner that the teachings of Lagrange *et al.* suggest the limitations of applicant's instant claims. Although Lagrange *et al.* do not use the language "firmly adhered" to, for the same reasons discussed in the first rejection, this is not considered to patentably distinguish the art from the instant applicant. One of ordinary skill in the art would look to the teachings of Lagrange *et al.* to formulate a cosmetic composition comprising a an applicator, and a powdered substance wherein the powdered substance is firmly adhered to the applicator. Without firm adherence,

the applicator would not function as desired. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

IT is the recollection of the examiner that during the interview applicant asserted that the main function of their invention was an article, with a powder firmly adhered to the article, where the powder coated article is then used to apply a separate and distinct makeup formulation. It is suggested that this concept be presented in the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is 703-308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, Alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



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